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Swiss IP News We provide you with updates on new decisions, the relevant legislative process and other trends in the fields of intellectual property and unfair competition law from a Swiss perspective.

“SWISS RE – WE MAKE THE WORLD MORE RESILIENT” – Federal Supreme Court confirms that the services claimed by the mark must not be limited to Swiss origin



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The Federal Supreme Court confirms the decision of the Federal Administrative Court regarding the registrability of the “SWISS RE – WE MAKE THE WORLD MORE RESILIENT” trademark (cf. our report [here](#)). It considered the service mark not to be misleading despite its geographical content and held that there was no need of a limitation of the services to Swiss origin (decision of 8 March 2021, 4A_361/2020)

Background

The lower instances had qualified the “SWISS RE – WE MAKE THE WORLD MORE RESILIENT” service mark as an indication of source according to art. 47(1) Trademark Act (“TMA”). The Institute of Intellectual Property (the “Institute”) had held that it would go beyond its capacity to verify whether an indication of source of a service mark was correct under art. 49 TMA. Particularly, it held that the newly adopted prerequisite of the place of effective administration according to art. 49(1)(b) TMA could not be subject to review in trademark examination. It therefore requested the list of services to be limited to Swiss origin. The Federal Administrative Court, upon an appeal filed by the trademark owner, found that the submitted extract from the commercial register for the trademark owner Swiss Re Ltd. did not only show that the trademark owner had its domicile in Switzerland but also that most of the persons with signatory powers resided in Switzerland. The court concluded that the criteria to be met in accordance with art. 49 TMA were available to examination with a justifiable effort. Accordingly, the

trademark in question was held not to be misleading and to be registered without any geographic limitation of the services. The Institute challenged this decision before the Federal Supreme Court.

Decision

The Federal Supreme Court dismissed the appeal and confirmed the decision of the Federal Administrative Court. It held that the newly adopted practice of the Institute according to which the risk of deception could not be countered other than by an explicit geographical limitation of the claimed services went too far. The court opined that if there was no risk of deception from the outset, there was no reason to restrict the list of goods or services.

In the present case, as the Federal Administrative Court had already bindingly found, the trademark in question fulfilled the requirements of art. 49(1) TMA because the registered office of the trademark owner was undisputedly located in Switzerland, as was the place of actual administration. Hence, the Federal Supreme Court concluded that the services offered by the trademark owner originated from Switzerland in terms of trademark law. Therefore, the “SWISS RE – WE MAKE THE WORLD MORE RESILIENT” trademark – even if it were to be understood as an indication of source which the Federal Supreme Court did not examine – was held admissible in accordance with arts. 2(c) and 47(3) TMA and was to be registered without any geographic limitation of the list of services. The court thus disapproved of the Institute’s justification for the request of a limitation due to

the concern of avoiding excessive examination efforts.

The Federal Supreme Court further evaluated that the risk of misleading of service marks could be assessed at the time of registration (and negated in the present case). The fact that the trademark might be transferred or licensed in the future to a person who might not meet the requirements of art. 49 TMA, as the Institute objected, did not change anything. However, the Federal Supreme Court also confirmed that this finding did not impact its own practice regarding trademarks with geographical elements that are protected for goods. Since the Institute, at the time of registration, cannot have any knowledge about the origin of the goods the trademark owner will offer under the trademark in the future, it will still be required to limit the protection to goods from the corresponding geographical area.

Comment

The Federal Supreme Court's disapproval of the Institute's undifferentiated position to make registration of all service marks with an indication of source dependent on a geographical limitation of the list of services for precautionary reasons and without any examination is important to globally operating Swiss companies if they use and protect signs incorporating geographic indications. The risk of a negative impact on their international filing strategy (see [here](#)) has been eliminated by the Federal Supreme Court's final judgement.

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